

## REMARKS

The Office Action mailed September 22, 2004 has been carefully considered. Claims 1-48 are active in this application. Further examination and reconsideration of the rejection of claims 1-48 are respectfully requested.<sup>1</sup>

### Rejections under 35 U.S.C. § 101

It appears that the Examiner has maintained the rejection under § 101 of claims 1-2, 11-15, 17-20, 22-24, and 26-31. However, in light of the fact that the Examiner has not expressly addressed Applicant's prior amendments to the claims in the "Response to Argument Section" of the Office Action suggesting that Applicants' prior arguments were "moot", it appears that the § 101 rejection language in the current Office Action may be a typographical error. In this regard, Applicants submit that independent claim 1 expressly calls for the use of a "processor." Paragraph 16 of the specification clearly describes a processor. Accordingly, Applicants request that the Examiner withdraw the rejection under § 101 or provide an explanation of why the Examiner believes that the claims do not satisfy § 101 so that the Applicants will know how to respond.

### Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected all claims as being obvious in view of U.S. Patent No. 5,948,040 to DeLorme et al. (DeLorme) Applicants respectfully disagree.

### Independent Claim 1

With regard to independent claim 1 (and amended claims 11 and 22), it is the Examiner's position that the *DeLorme* reference discloses all of the limitations of these claims while conceding that the reference does not disclose:

processing the requested information and location information with at least one processor so as to select audio-visual content based on said request and regardless of said location information;

Office Action p. 3. For this limitation, Examiner asserts that it would be obvious to modify the device of *DeLorme*. The Examiner does not cite any reference disclosing the feature of such a modification and indeed only relies on a single passage in *DeLorme* to support the proposed modification. In this regard, the Examiner supports the contention based on statements in *DeLorme* reciting that: "focusing and shaping individualized, computer-aided information processes around flexible combinations of place, time, topic and transaction inquiries and responses" and "planning can be optimized." Based on these isolated, fragmented statements alone, the Examiner proposes that the modification of Applicants' invention is suggested. Applicants respectfully submit that the Examiner's reliance

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<sup>1</sup> Claims 1, 11 and 22 have been amended in this Amendment for purposes of improving readability of the claims rather than to change any meaning of the claims.

on these statements as a suggestion of Applicants' invention is not proper.

Significantly, in reviewing the prior art to determine whether an invention is obvious, it is improper to take a statement out of the context of the applied reference. Rather, the entire reference must be considered. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983) (District court erred in obviousness determination by "considering the references in less than their entireties."). Generally, there is no suggestion or motivation when the whole of the reference teaches away by leading others in a direction divergent from the path taken by the applicant. *Tec Air, Inc. v. Denso Mfg. Michigan, Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

To this end, the complete statements in context of the applied reference upon which the Examiner relies are as follows:

An advantage of the invention is that travel planning can be optimized in an iterative process which incorporates reserving, purchasing, and ticketing the planned travel quickly and personally.

Col. 7, lines 35-38 (emphasis added).

In addition, the TRIPS invention manages diverse travel planning needs, focusing and shaping individualized, computer-aided information processes around flexible combinations of place, time, topic and transaction inquiries and responses.

Col. 7, lines 56-60 (emphasis added). With regard to the context of these statements, "TRIPS" is defined by *DeLorme* as being:

a Geographical Information System (GIS). Such a GIS manages data in the GIS database in relation to geographical coordinate locations of a selected geographical coordinate system. Thus, the TRIPS database manager relates point of interest and any other loc/objects of the database with particular locations on or near the surface of the earth in terms of coordinate locations such as latitude and longitude. The multimedia information hereafter described is similarly identified with the coordinate location of the subject POIs.

The TRIPS software constructed for user travel planning permits user selection of a travel origin, travel destination and desired waypoints between the travel origin and travel destination.

Col. 8, lines 23-37 (emphasis added). Thus, when read in context in the manner that is required, it is clear that the statements relied upon by the Examiner do not suggest Applicants' invention. To the contrary, they suggest only the use of geographical travel information particularly associated with geographical coordinates as contained in the disclosed database. In this regard, it clearly teaches away from the Applicant's invention.

Moreover, Applicants respectfully remind the Examiner that in proposing a modification of a reference, the principle of that reference cannot be changed. See *Application of Ratti*, 270 F.2d 810, 813 (CCPA 1959) (Examiner's proposed modification cannot change a principal

of operation of the prior art reference.) It is clear that the principal of the *DeLorme* reference is to associate all available information with geographical coordinates information.

Thus, *DeLorme* does not contemplate or suggest the possibility that the user will ask for one type of information which is independent of the location, and in response get both that information and information which is particular to the location of the device.

Figure 1 provides an illustration of one way in which the claim may be implemented. As can be seen, a device requests information from the same website, namely [www.a.com](http://www.a.com), from two different locations. The requested information, which in this case is the information available at [www.a.com](http://www.a.com), remains the same regardless of the location. Location-specific information may not have been specifically requested. Even so, the information provided from the web server includes both (a) audio/visual content which is responsive to the requested information "regardless of said location information" (such as text 72 and pictures 73 at [www.a.com](http://www.a.com)) and (b) geographically-oriented information which is based on the location information. (The recitation of "audio-visual content" means audio and/or visual content.)

To the extent that there is any confusion as to this aspect of claim 1, the Applicants previously amended the claim to clarify that the response information includes "both" types of information and is being sent in response to the "said request." While not all of the information must come from the same source or server, the information sent in response to the original request must therefore include both types of information.

This particular advantage of the claim is recited right in the specification itself. The specification states "one of the advantages of the present invention is that in response to requests for information from users, the server provides not only the requested information but other information which is relevant to the current location of the user." See Paragraph 26.

In sum, *DeLorme* clearly does not teach selecting (a) content based on a user request and *regardless* of said location information; and (b) geographically-oriented information based on the location information. Moreover, such a modification would be inconsistent with *DeLorme* in light of its teaching that multimedia information is identified based on "coordinate location[s]."

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1, 11 and 22.

Independent Claims 32 and 41

With regard to independent claim 32 and 41, the Examiner essentially repeats the rejection of claim 1. However, Applicants respectfully submit that in light of the teachings of *DeLorme* which require that all information accessible by the TRIPS software/database be related "with particular locations on or near the surface of the earth in terms of coordinate locations such as latitude and longitude" as discussed above (Col. 8, lines 26-30), the reference does not suggest or teach a request for neutral content or information distinct from location information and to the contrary teaches away from such a transfer. Accordingly, Applicants submit that these claims are in condition for allowance.

Claims 2-31, 33-40 and 42-48

Applicants take further exception to the Official Notice referenced at pages 5, 6 and 8 of the Office Action with respect to claims 2-31, 33-40 and 42-48 stating that "[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to include elements and limitations of claims ... because ...(see *DeLorme* (col.1, ll. 40-45))." The Official Notice is respectfully traversed for the reason that the suggestion set forth in the Office Action is taken out of context or otherwise inconsistent with disclosure of *DeLorme* as set forth above. Applicants hereby requests that the authority for the statements set forth in the Official Notice be produced.

Nevertheless, Applicants submit that the allowance of claim 1, 11, 22, 32 and 41 requires allowance of their dependent claims. The dependent claims incorporate the novel and non-obvious invention of the parent claim, in addition to the novel and non-obvious features contained in them. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-31, 33-40 and 42-48.



**CONCLUSION**

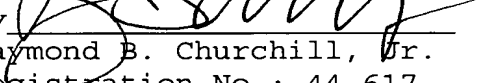
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: December 22, 2004

Respectfully Submitted,

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